

### **C. REMARKS**

The Examiner is thanked for the performance of a thorough search. No claims have been canceled or added in this reply. Hence, Claims 1-15 are pending in this application. The specification has been amended to address various informalities raised by the Examiner. The amendments to the specification and claims do not add any new matter to this application. All issues raised in the Office Action mailed January 18, 2007 are addressed hereinafter.

#### **OBJECTION TO SPECIFICATION**

The specification is objected to on the basis that various informalities are requested to be corrected. The specification has been amended as indicated herein to address these issues. Accordingly, reconsideration and withdrawal of the objection to the specification is respectfully requested.

#### **OBJECTION TO CLAIMS 1-5, 10 AND 12-14**

Claims 1-5, 10 and 12-14 are objected to because of various informalities that have now been corrected by amendment, as indicated herein. Accordingly, reconsideration and withdrawal of the objection to Claims 1-5, 10 and 12-14 is respectfully requested.

#### **REJECTION OF CLAIMS 1-15 UNDER OBVIOUSNESS-TYPE DOUBLE PATENTING**

Claims 1-15 are rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 12 and 16-26 of co-pending U.S. Patent Application No. 10/776,486. A proper terminal disclaimer complying with 37 CFR 3.73(b) is filed herewith. Accordingly, reconsideration withdrawal of this double patenting rejection is respectfully requested.

#### **REJECTION OF CLAIMS 1-15 UNDER 35 U.S.C. § 101**

Claims 1-15 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-15 have been amended to recite a device that includes numerous hardware elements, such as network interface, one or more processors and a memory. It is believed that Claims 1-15, as amended, fully satisfy the requirements of 35 U.S.C. § 101. Accordingly, reconsideration withdrawal of the rejection of Claims 1-15 under 35 U.S.C. § 101 is respectfully requested. If the Examiner believes that the claims, as amended, still are not directed to statutory

subject matter, then Applicant respectfully requests that the Examiner clearly articulate the legal standard being applied to determine whether the claims pass muster under 35 U.S.C. § 101 so that Applicant may respond appropriately in the next reply to further the prosecution of this application. The Examiner is also invited to contact the undersigned directly via telephone if the Examiner believes that such contact would be helpful for resolving any remaining issues under 35 U.S.C. § 101.

### **REJECTION OF CLAIMS 1-7, 11 AND 15 UNDER 35 U.S.C. § 102(b)**

Claims 1-7, 11 and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Walsh et al.*, U.S. Patent No. 5,956,481 (hereinafter "*Walsh*"). It is respectfully submitted that Claims 1-7, 11 and 15, as amended, are patentable over *Walsh* for at least the reasons provided hereinafter.

#### **CLAIM 1**

Claim 1 is directed to a multi-function peripheral device and recites:

“a network interface configured to allow the multi-function peripheral device to communicate with network devices over a network;  
a graphical user interface configured to allow for the exchange of information between the multi-function peripheral device and a user;  
one or more processors;  
a memory;  
a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-function peripheral device and to generate scan data that includes a digital data representation of the electronic document;  
a print process executing in the memory and being configured to process print data and cause a printed version of an electronic document reflected in the print data to be generated by the multi-function peripheral device at the multi-function peripheral device; and  
a virus protection process executing in the memory and being configured to detect that one or more unauthorized instructions have been stored on the multi-function peripheral device; and  
in response to detecting that the one or more unauthorized instructions have been stored on the multi-function peripheral device, perform one or more actions to address the one or more unauthorized instructions that have been stored on the multi-function peripheral device.”

The multi-function peripheral device recited in Claim 1 includes a scan process, a print process and a virus protection process that execute in a memory of the multi-function peripheral

device to provide scanning, printing and virus protection services. Providing all of these services in a single multi-function peripheral device provides many benefits.

It is respectfully submitted that at least these features of Claim 1 are not taught or suggested by *Walsh*. To the extent that *Walsh* describes implementing these services on a device, it is in the context of the virus process executing on a computer and the printing and scanning processes executing on a different device than the computer where the virus protection process executes. For example, *Walsh* describes that other peripheral devices may be connected to processing unit 21 via an interface, such as a USB interface. In this situation, the print process or scan process executes on a separate device and not in the memory of the multi-function peripheral device along with the virus protection process. Thus, multiple devices would be required to provide these services. It is therefore respectfully submitted that a single multi-function peripheral device having a memory with a scan process, a print process and a virus protection process executing therein as recited in Claim 1 is not taught or suggested by *Walsh* and that Claim 1 is therefore patentable over *Walsh*.

#### CLAIMS 2-7, 11 AND 15

Claims 2-7, 11 and 15 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 2-7, 11 and 15 are patentable over *Walsh* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 2-7, 11 and 15 recite additional limitations that independently render them patentable over *Walsh*.

In view of the foregoing, it is respectfully submitted that Claims 1-7, 11 and 15 are patentable over *Walsh*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-7, 11 and 15 under 35 U.S.C. § 102(b) as being anticipated by *Walsh* is respectfully requested.

#### REJECTION OF CLAIMS 8-10 AND 12-14 UNDER 35 U.S.C. § 103(a)

Claims 8-10 and 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Walsh* in view of *Boldon et al.*, U.S. Patent Publication No. 2003/0048468 (hereinafter "*Boldon*"). It is respectfully submitted that Claims 8-10 and 12-14 are patentable over *Walsh* and *Boldon*, alone or in combination, for at least the reasons provided hereinafter.

Claims 8-10 and 12-14 depend from Claim 1 and include all of the limitations of Claim 1. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or

suggested by *Walsh*. It is also respectfully submitted that these limitations are also not taught or suggested by *Boldon*. For example, it is respectfully submitted that a multi-function peripheral device having a memory and a scan process, print process and virus protection process executing in the same memory on the multi-function peripheral device as recited in Claim 1 and included in Claims 8-10 and 12-14 by dependency is not taught or suggested by *Boldon* and it is understood that *Boldon* was not relied upon for teaching these limitations. It is therefore respectfully submitted that Claims 8-10 and 12-14 are not taught or suggested by *Walsh* and *Boldon*, considered alone or in combination, and are patentable over *Walsh* and *Boldon*. Accordingly, reconsideration and withdrawal of the rejection of Claims 8-10 and 12-14 under 35 U.S.C. § 103(a) as being unpatentable over *Walsh* in view of *Boldon* is respectfully requested.

### CONCLUSION

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



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Date: April 17, 2007

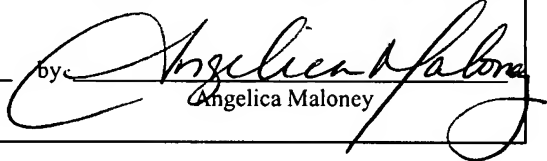
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#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Amendment**, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on April 17, 2007

by

  
Angelica Maloney